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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,351	08/04/2003	Chon Yie Lin	2002B107A	8824
23455	7590	11/16/2007	EXAMINER	
EXXONMOBIL CHEMICAL COMPANY 5200 BAYWAY DRIVE P.O. BOX 2149 BAYTOWN, TX 77522-2149			LEE, RIP A	
			ART UNIT	PAPER NUMBER
			1796	
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			11/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

<b>Application No.</b> 10/634,351	<b>Applicant(s)</b> LIN ET AL.	
<b>Examiner</b> Rip A. Lee	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 04 September 2007.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-12, 16, 17, 19, 20, 22-33, 35, 57-62, 65-70 and 73-85 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-12, 16, 17, 19, 20, 22-33, 35, 57-62, 65-70, 73-85 is/are rejected.
- 7)  Claim(s) 7 and 27-32 is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_

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### DETAILED ACTION

This office action follows a response filed on September 4, 2007. Claims 1-12, 16, 17, 19, 20, 22-33, 35, 57-62, 65-70, 73-85 are pending.

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 33, 59, 62, 65-70, 73-85 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The exact subject matter of the claims is unclear because elastomers are substantially absent in the claimed compositions, yet said compositions further contain plastomer. Since plastomers are a subset of the generic class of elastomer, the claimed subject matter does not appear internally consistent. While there are subtle differences between elastomer and plastomer, these are not evinced in the claims to the extent that the subject matter of the claims is unambiguous.

#### *Claim Rejections - 35 USC § 102 / 35 USC § 102*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-4, 6, 7, 10-12, 19, 20, 57, 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwasaki *et al.* (U.S. 5,240,966); see also office action dated December 5, 2005.

Iwasaki *et al.* teaches a material comprising 500 g of polypropylene treated with 150 g of Lucant HC-10 (pour point = -53 °C, MW = 590, specific gravity = 0.826, KV<sub>100</sub> = 10 cSt; example 8). After lyophilization, the sample would contain a maximum of 0.45 wt % of non-functionalized plasticizer.

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5. Claims 5, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki *et al.* (U.S. 5,240,966).

The prior art does not recite the claimed properties, however, a reasonable basis exists to believe that the materials of the prior art exhibit the claimed features, especially in view of the fact that they are substantially the same as those recited in the instant claims. Since the PTO can not conduct experiments, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d. 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-2112.02. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

6. Claims 1-12, 16, 20, 57, and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Brant (U.S. 6,639,020).

Brant teaches a plasticized polypropylene composition comprising 50-99.9 wt % of polypropylene, 0.1-50 wt % of ethylene copolymer having  $M_w$  in the range of 500-10,000, and up to 20 wt % of modifier. The ethylene copolymers have a  $T_g$  of from about -80 °C to about -30 °C (col. 5, lines 25-28). For example, "copolymer 5" in Table 2 has a  $T_g$  of -76 °C and a viscosity of 200 cP at 90 °C. Since  $T_g$  is -76 °C, the polyolefin would have a pour point of less than -30 °C. The density of the polymer is not shown, however, it is reasonable to expect that polyolefins have a density in the range of 0.80-0.90 g/cm<sup>3</sup>. Kinematic viscosity is defined as the ratio of viscosity to density. The polyolefin has a viscosity of 200 cP = 2 P = 2 g/cm-sec. Dividing by a density of 0.80 g/cm<sup>3</sup> yields a kinematic viscosity of 2.5 cm<sup>2</sup>/sec = 2.35 St = 235 cSt. Thus, it is reasonable to conclude that the polyolefin exhibits a kinematic viscosity greater than the cited minimum value of 10 cSt even at 100 °C. Modifiers include slip agents (col. 8, line 10).

The applied reference appears to have a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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### *Double Patenting*

7. Claims 1-12, 16, 17, 19, 20, 22-33, 35, 57-62, 65-70, 73-85 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33, 35, and 57-89 of copending Application No. 11/433,623. Although the conflicting claims are not identical, they are not patentably distinct from each other because of substantial overlapping subject matter. Both inventions are drawn to essentially the same composition comprising 60-99.9 wt % of propylene and 0.1-40 wt % of non-functionalized plasticizer that is a C<sub>6</sub>-C<sub>200</sub> paraffin and having a pour point of less than -30 C° and KV<sub>100</sub> = 10-500 cSt.

8. Claims 17-32, 35, 60, and 61 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17-55 (see in particular claim 38) of copending Application No. 11/406,926. Although the conflicting claims are not identical, they are not patentably distinct from each other because to essentially the same composition comprising 60-99.9 wt % of propylene and 0.1-40 wt % of non-functionalized plasticizer that is a C<sub>6</sub>-C<sub>200</sub> paraffin and having a pour point of less than -30 C° and KV<sub>100</sub> of greater than 10 cSt.

9. Claims 1-12, 16, 17, 19, 20, 22-33, 35, 57-62, 65-70, 73-85 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 79-105, 107, 121-126, 208, 212, 214, 216, 220, 223, and 225 of copending Application No. 10/640,435. Although the conflicting claims are not identical, they are not patentably distinct from each other because of substantial overlapping subject matter. Both inventions are drawn to essentially the same composition comprising 60-99.9 wt % of propylene and 0.1-40 wt % of non-functionalized plasticizer that is a C<sub>6</sub>-C<sub>200</sub> paraffin and having a pour point of less than -30 C° and KV<sub>100</sub> of greater than 10 cSt.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

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***Claim Objections***

10. Claims 7 and 27 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The kinematic viscosity range lies outside that specified in independent claims 1 and 17.

11. Claims 27-32 are objected to because of the following informalities: Please remove the extra comma after "claim 17." Appropriate corrections are required.

***Response to Arguments***

12. All rejections of claims based on Klingensmith *et al.* (U.S. 4,536,537) and Suokas *et al.* (WO 98/44041) have been overcome by amendment.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



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November 13, 2007